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*In re* Application of  
AZZAR, JIM : DECISION ON PETITION  
Serial No.: 10/659,861 : TO WITHDRAW FINALITY  
Filed: September 11, 2003 : OF REJECTION AS  
Docket: HOL01 P-102 : PREMATURE UNDER  
Title: FOOD TRAY LINER : 37 CFR 1.181

This is a decision on the petition filed on May 30, 2006 by which petitioners request supervisory review and withdrawal of the finality of the Office Action dated April 5, 2006. The petition is considered pursuant to 37 CFR 1.181, and no fee is required.

The petition is GRANTED.

The record shows:

On September 11, 2003 the applicant filed the current application with original claims. On October 19, 2005 the examiner issued a first Office Action which rejected the claims under, *inter alia*, 35 U.S.C. 102 and 35 U.S.C. 103 in light of the prior art Columbo. On January 19, 2006 the applicant filed an amendment, amending Claims 3, 18, 22, and 24. On April 5, 2006 the examiner issued a final Office Action which rejected the claims under 35 U.S.C. 102 and 35 U.S.C. 103 in light of the prior art Walker. The examiner stated, "Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL."

On May 30, 2006 the applicant submitted the current petition requesting a withdrawal of the finality of the previous Office Action. The petitioner is of the opinion that the finality of the Office Action was premature. In particular, the applicant alleges that the April 5, 2006 Office Action should not have been final since "Claim 3 was merely rewritten in independent form". Therefore, the amendment to Claim 3 did not necessitate the new grounds of rejection; instead, Applicant argued that the prior rejection, which was based on U.S. Patent No. 5,266,763 to Colombo, was without merit. Therefore, Applicant's amendment to Claim 3 did not necessitate the new grounds of rejection."

Analysis of Application Record

MPEP 706.07(a) states in relevant part: “Under present practice, second or any subsequent actions on the merits shall be final, *except where the examiner introduces a new ground of rejection that is neither necessitated by applicant’s amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).*” (*Emphasis added*).

The issue presented in the current petition is whether the new Claim 3 changed the scope of the original claim 3 and necessitated a final rejection.

In order to determine whether or not the original Claim 3 and the new Claim 3 are equivalent, a comparison of the claims must be made. Claim 3 rewritten as an independent claim must necessarily combine the original Claims 1 and 3 without changing the scope of the claim. The original Claims 1 and 3 which were filed on September 11, 2003 are reproduced below.

1. A food tray assembly comprising:
  - a tray, said tray having a base wall and sidewalls extending up from said base wall to form a cavity, said base wall having an inner surface, and said sidewalls having inner surfaces; and
  - a preformed flexible liner, said preformed flexible liner configured and arranged to substantially conform to said inner surfaces of said base wall and said sidewalls to form a liquid containing bowl in said cavity for holding food and liquid therein.
3. The food tray assembly according to Claim 1, wherein said liner comprises a preformed flexible paper liner.

The amended Claim 3 which was filed on January 19, 2006 is also reproduced below.

3. A food tray assembly comprising:
  - a tray, said tray having a base wall and sidewalls extending up from said base wall to form a cavity, said base wall having an inner surface, and said sidewalls having inner surfaces; and
  - a preformed flexible paper liner, said preformed flexible paper liner configured and arranged to substantially conform to said inner surfaces of said base wall and said sidewalls to form a liquid containing bowl in said cavity for holding food and liquid therein.

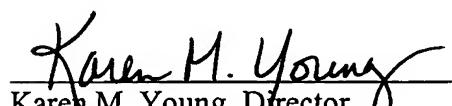
The new Claim 3 is identical to the original Claim 1, except “a preformed flexible liner, said preformed flexible liner . . .” has been changed to “a preformed flexible *paper* liner, said preformed flexible *paper* liner . . .” (*Emphasis added*). However, the addition of “paper” to the claim is consistent with the original dependent Claim 3, “wherein said liner comprises a preformed flexible paper liner.” Therefore, the new Claim 3 does not change the scope of the original Claim 3.

Accordingly, the amendment to Claim 3 did not necessitate the new grounds of rejection. The introduction of the new reference with a final rejection was improper. The finality of the Office Action of April 5, 2006 is, therefore, vacated.

The application is being forwarded to the Supervisory Patent Examiner of Art Unit 3727 who will have the examiner to withdraw the finality of the Office Action of April 5, 2006 and promulgate an Office action not inconsistent with this Decision.

Any inquiry regarding this decision should be directed to Henry Yuen, Special Program Examiner, at (571) 272-4856.

PETITION GRANTED.

  
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Karen M. Young, Director  
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